

REMARKS

The Examiner is thanked for the thorough examination of this application. The Office Action, however, tentatively rejected all claims 1-19. After entry of the foregoing amendments, in which claims 1-6 have been canceled, claims 7-19 remain pending.

Rejections Under 35 U.S.C. 102(e)

Claims 1, 3, and 5 were rejected under 35 U.S.C. §102(e). Applicant's cancellation of these claims has rendered these rejections moot.

Rejections Under 35 U.S.C. 103(a)

The Office Action has tentatively rejected claims 7-9, 11-17 and 18-19 under 35 U.S.C. 103(a) as allegedly unpatentable over Backs et al. (U.S. 6,531,833) in the view of Knoble (U.S. 5,115,165). For at least the reasons set forth below, Applicant respectfully requests reconsideration of these rejections.

Claim 7 defines an electronic device having an illumination circuit, comprising *a first load, wherein a current flowing on the first load is reduced as time increased*, an AC driving unit for generating an AC current to drive the first load, a current transformer having a primary winding and a secondary winding, wherein the primary winding is coupled between the first load and the AC driving unit, such that the secondary winding generates an induced current, a second load having an illumination function, wherein brightness of the second load is changed according to an AC driving voltage and wherein the brightness of the second load corresponds to an operating duration of the first load, and a transformation device, connected with the secondary

winding and the second load in parallel, for transforming the induced current to the AC driving voltage to drive the second load.

The first load of the embodiment of claim 7 is driven by an AC driving unit and has a current reduced as time increased. In page 4, the Office Action states that element 24 (shown in Fig. 4 of Backs) can correspond to the first load of the invention. However, as recited in the specification of Backs, the primary winding 18 receives an A.C. power signal from a source 24 (col 2 lines 42-43). Therefore, Backs does not teach or suggest that the first load of the claimed embodiment is driven by an AC driving unit and has a current reduced as time increased.

For at least this reason, claim 7 patently defines over the cited references. Insofar as claims 8-13 depend from claim 7, these claims 8-13 are also allowable.

Similarly, Backs does not teach or suggest the first load defined in claim 14. Thus, claim 14 allowable over the cited reference. Insofar as claims 15-19 depend from claim 14, these claims 15-19 are also allowable.

As a separate and independent basis for the patentability of all pending claims, the Office Action has failed to identify a proper suggestion or motivation to combine the selective teachings of *Backs* and *Knoble*. In this regard, it is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be

founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to realize an electronic device with an illumination circuit, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *Gambro Lundia AB*, 110 F.3d at 1579, 42 USPQ2d at 1383 ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, No 98-1553 (Fed. Cir. January 27, 2000). Well-established Federal Circuit case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Evidence of teaching or suggestion is "essential" to avoid hindsight. *In re Fine*, 837 F.2d 1071, 1075 (Fed.Cir.1988). A description of the particular "teaching or suggestion or motivation [to combine]" is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed.Cir.1998). Indeed, in forming an obviousness type rejection, "the [Examiner] must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them." *In re Rouffet*, 149 F.3d 1350, 1359 (Fed.Cir.1998). The Examiner can satisfy this burden of establishing obviousness in light of combination "only by showing some objective teaching [leading to the combination]." *In re Fritch*, 972 F.2d 1260, 1265 (Fed.Cir.1992).

In combining *Knoble* with *Backs*, the Office Action merely concluded that it would have been obvious "because this could be used as an indicator to determine if the supplied power is

stable or not..." (Office Action, p. 5). This basis is clearly improper, as such a conclusory, result-oriented basis could be used to reject virtually any patent claim on an improvement system that results in a device or method that realizes some perceptible improvement over the prior art. Improvements of this sort are the very basis that underscores the purpose of the patent system (e.g., the improvement of technology), and the rejection embodies clear (and improper) hindsight reasoning.

Simply stated, the Office Action has failed to comply with these legal standards. Consequently, the rejections of the claims are legally improper and must be withdrawn.

CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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